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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,426	08/21/2001	Eduardo Schiffrin	112701-305	7769
29157	7590	02/18/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			SAYALA, CHHAYA D	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,426

Applicant(s)

SCHIFFRIN ET AL.

Examiner

C. SAYALA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4 and 6-10, 13-19, 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0850569.

'569 teaches a pet food containing inulin or chicory, which the patent teaches, improves gastrointestinal tract health of the pet by promoting the growth of lactic and bifido-bacteria. See page 2. Additionally, the patent teaches that the promotion of such growth, at the cost of pathogenic bacteria, has various beneficial effects: prevention and treatment of diarrhoea, increased growth, improved ability to breed and enhanced health. See page 1, paragraph 2. See example 1. The diet contains cereal. Enhanced health would inherently increase the activity of the pet. Examples show dogs and the benefits of administering the composition therein, and the claims are drawn to pets,

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which effect claimed herein would inherently occur because the method shown by the reference includes the same composition, in the same amounts to the same animals.

2. Claims 1-4 and 6-10, 13-19, 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 99/22604.

'604 teaches a pet food containing chicory, which the patent teaches, improves gastrointestinal tract health of the pet by promoting the growth of colonic flora, i.e. the enhancement of beneficial bacteria. See page 1, paragraph 2 and page 5, lines 1-7 and page 6, lines 3+. Additionally, the patent teaches that the promotion of such growth, at the cost of pathogenic bacteria, has several beneficial effects, among which is the impact on the pet's overall health. See the claims and example 1. The diet contains cereal. Enhancement of the overall health of any pet would inherently increase the activity of the pet. Examples are drawn in particular to dogs.

3. Claims 1, 3, 7-8, 11, 13-19, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0862863.

'863 teaches that probiotics are beneficial for gastrointestinal tract health in pets. See page 1. The patent teaches that the probiotic microorganisms inhibit the growth of pathogenic bacteria and thus they are useful in treatment and conditions caused by pathogenic bacteria and furthermore, they inhibit the growth and activity of pathogenic putrefying bacteria and the consequent production of toxic amine compounds. Probiotic micro-organisms activate the immune function of the host. Also see page 5,

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line 58 for claim 11 limitations. Improving GI tract health, inhibiting growth and activity of pathogenic bacteria and activating the immune function of the pet, would inherently increase the activity of the pet. See example 5.

4. Claims 1-4 and 6-10, 13-19, 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Reinhart (US Patent 5776524).

The Reinhart patent teaches feeding pets 0.2-1.5 wt% of inulin in a diet that includes corn, to reduce pathogenic bacteria. The patent teaches that harmful bacteria causes diseases in the gastrointestinal tract causing decreased motility, intestinal disease, diarrhoea, etc. Reestablishment of the proper microflora helps the animal to regain gastrointestinal health and normalcy. The mechanism of this is shown at col. 2, lines 1-10. Animal shown are cats, dogs, etc. Examples show the benefits. The amounts are the same, the pets are the same and the composition is the same. The method and effects are therefore, inherent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 5, 7-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/22604, EP 0850569 and Reinhart in view of EP 0862863, Shields et al. (US Patent 6156355), and Lowe ('Canine Nutrition', Biotechnology in Feed Industry, pages 275-287, 1988) and further in view of Bui et al. (US Patent 6596303) and Bockow (US Patent 5709855).

The WO, EP '569 and Reinhart patents are as discussed above. They teach that inulin or chicory when combined in pet food that contains cereal (example 1 in 'WO 604; page 1, line 41, example 1 in '569), in amounts as shown at page 4, lines 1-5, page 7, lines 1-9 in WO '604, page 1, lines 40-42, 44, 55-56, page 2, lines 44-45, page 3, lines 38-40 in EP '569, enhance health and the promotion of lactic and bifido-bacteria at the expense of pathogenic bacteria, increase growth of the pet and help increase overall health. Reinhart is as discussed above. They do not teach that the dogs were elderly or that the feeding of chicory ameliorates joint stiffness. The patents do not teach the addition of long chain fatty acid.

EP '863 teaches that probiotic bacteria aids the inhibition of the growth and activity of pathogenic bacteria and they are useful in the treatment and conditions caused by such bacteria. The patent also teaches that the probiotic bacteria activates the immune functions. See example 5; and page 5, line 56, which discloses the cell numbers of microorganism used. Furthermore, Shields Jr et al. teach that the addition of probiotics and prebiotics in a diet for dogs is advantageous for gastrointestinal function. See cols. 11 and, 12 at lines 1-10.

It would have been obvious to one of ordinary skill in the art at the time invention was made that not only will such enhancement occur in all dogs, but also in dogs that are elderly. It would have been obvious that the benefits shown for all dogs would extend to benefit elderly dogs too because they too would experience overall health improvements, enhanced health benefits such as increased immune function and hence an increase in pet activity for such elder dogs also. Moreover, Lowe teaches that a reduced efficiency of the digestive tract occurs as a result of age and infection. See page 280. He teaches that treatment with probiotics aids states of infection with pathogenic bacteria. See page 280. The reference states that when gastrointestinal tract health is compromised, digestive efficiency is reduced and opportunistic pathogens have a rapid growth rate and this may lead to infections. It would have been obvious to one of ordinary skill in the art that probiotics and/or prebiotics help the GI tract to maintain not only the health of the dog but also maintain the profile of a healthy, active dog, as taught by each of the EP and WO patents and reinforced by Shields, Jr et al.

Even though none of the references above teach that fatty acids are beneficial, Bui et al and Bockow establish that it was known in the art at the time the invention was made that a dog suffering from degenerative arthritis, tendonitis, etc, when treated with omega-3 fatty acid is considerably relieved from such a condition. See example 3, claims 1-6 in Bockow et al. Bui et al teach the administration of mussel extracts which are rich in omega fatty acids (see col. 3, lines 1-30) are beneficial to cats and dogs that are arthritic. The extract reduces inflammation exhibited in such conditions. See the claims. It would have been obvious to incorporate fatty acids in diets for pets that are

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suffering from conditions such as joint stiffness for the alleviation of the inflammatory response that accompanies such conditions. Furthermore, it would have been obvious to one of ordinary skill in the art to treat or ameliorate joint stiffness by adding probiotics or prebiotics because the primary references teach that these compositions reduce pathogenic bacteria and it is well known that such bacteria elicit an increased inflammatory status in the host (see instant claim 18).

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patents to Matsuura et al. and Horrobin establish that long chain fatty acids are beneficial to skin disorders that seem to plaque animals as they age. See col. 1, in '088.

Response to Arguments

Applicant's arguments filed 11/22/2004 have been fully considered but they are not persuasive.

Applicant has argued that "enhanced health does not inherently increase the activity of a pet. To satisfy the test for inherency an increase in pet activity would necessarily have to follow from an improvement in pet health. That condition simply is not met under the present circumstances. For example, a pet may be a normal active pet or even an anxious pet that is overly active. While such a pet could benefit from improved health by consuming the pet food of the '569 patent, it would not necessarily

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follow that such a pet would have improved activity as required for inherency. Also, a pet may ingest the pet food of the '569 patent and may benefit from improved health but not to such an extent that the activity of the pet is improved as would be required for inherency. Thus, it cannot be said that improved health would inherently improve the activity of a pet".

The method step in the art is the same: the same composition is administered to the same animal in the same amount. Therefore, the same result must have occurred: the method is inherent. Applicant states that the art does not show improved pet activity. 'It is well settled that a patent cannot be properly granted for [an invention] which would flow naturally from the teaching of the prior art.' " *American Infra-Red Radiant Co. v. Lambert Indus., Inc.* , 360 F.2d 977, 986 [149 USPQ 722 (CCPA 1958)], (8th Cir.) (quoting *Application of Libby*, 255 F.2d 412 [118 USPQ 194 (CCPA 1958)], *cert. denied*, 385 U.S. 920 [151 USPQ 757] (1966). Also see "Response to arguments" in the paper filed 7/26/2004.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

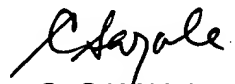
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA at Group 1761, telephone number (703) 308-3035.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0661.



C. SAYALA
Primary Examiner
Group 1700.